UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,314	11/20/2001	Lawrence E. Rentz	243768047US	9509

25096 7590 07/29/2004		EXAMINER	
PERKINS COIE LLP		POND, ROBERT M	
PATENT-SEA			
P.O. BOX 1247		ART UNIT	PAPER NUMBER
SEATTLE, WA 98111-1247		3625	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/989,314	RENTZ, LAWRENCE E.
	Examiner	Art Unit	
	Robert M. Pond	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _20 November 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-27_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-27_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _19 February 2002_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _8/06/02_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Specification

1.   The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2.   **Claims 1-19 and 25-27 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts to support the core invention. System components as claimed (and means) are software components lacking structural specificity. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at

1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2dat 1452.

3.   **Claims 20 and 21 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The Applicant is claiming data structure in a computer readable medium. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material"

includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214

USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199,

206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus,

nonstatutory music is not a computer component and it does not become

statutory by merely recording it on a compact disk. Protection for this type of

work is provided under the copyright law.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

4.   **Claims 1-4 and 11-27 are rejected under 35 USC 103(a) as being**

unpatentable over Durand et al. (patent number 6,272,467 hereinafter

referred to a "Durand").

Durand teaches an automated system and method for identifying matches

between a set of predetermined traits and a set of preferences. Durand teaches

a method used to find compatible matches in a variety of situations where

participants are identified by a profile of traits and a set of criteria desired in a

match (see at least abstract; col. 1, lines 9-20; col. 2, line 58 through col. 3, line

7). Durand teaches by example, matching a job hunter with a potential employee

(see at least col. 1, lines 15-17) (please note examiner's interpretation:

individuals and organizations use the automated service. An individual person or

organization is hereinafter referred to as a participant) (see at least col. 1, lines

11-14). Durand further teaches:

- *Receiving information about an participant:* participant inputs traits (please

  note examiner's interpretation: participant traits are parameters used by

  the matching program performing the query) and preferences (please note

  examiner's interpretation: preferences in combination with traits produce a

  compatibility report to the user- see generating reports below); input

  means for collecting information; computer system means (see at least

  Fig. 1 (1, 2); Fig. 2 (Fig. 4 (57, 60); col. 6, lines 46-49; col. 8, line 41).

- *Storing the participant information for a plurality of entities:* stores

  participant traits and preferences; storage means (see at least Fig. 1 (4);

  Fig. 2 (8, 9,12); Fig. 4 (59, 62); col. 6, lines 49-50; col. 8, line63-65).

- *Evaluating the information found in the search:* query database and

  generate list of potential matches; database searching means (see at least

  Fig. 5 (72, 73); col. 2, line 58 through col. 3, line 7; col. 12, lines 16-27).

- *Identifying potential synergy between two entities based on the participant*

  information: sorting compatible matches; generating compatibility score;

  presenting to participant (see at least Fig. 5 (74-80); col. 12, lines 16-53).

- *Generating a report:* reports matches to participant; generates reports

  (see at least col. 6, lines 51, 65); match retrieval using a video display;

  reporting each match and characteristics (see at least col. 18, line 65

  through col. 19, line 3; col. 19, lines 21-24).

- *Computer readable medium:* computer with memory executing the matching application (see at least Fig. 1 (3); Fig. 2 (9, 10); col. 6, lines 9-47).

- *Data structures; asset information:* participant asset information organized by data structures (see at least Fig. 3 (17); 3a (17, 20-32); col. 6, line 66 through col. 7, line 8); employer preferences, education level, skills, participant size (e.g. company size) (see at least col. 20, lines 12-22).

- *Company-to-Companies compatibility matching:*

    Durand teaches all the above as noted under the 103(a) rejection and teaches a) participants using the search and matching method as individuals or companies desiring to facilitate a relationship, b) a participant looking for other compatible participants (e.g. individual-to-individuals, individual-to-companies), c) company searching for compatible employees (company-to-individuals), and further teaches the method being useful in finding compatible matches in a variety of situations where participants are identified by a profile of traits and a set of criteria desired in a match. Durand, however, does not disclose a situation to accommodate company-to-companies compatibility matching. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Durand to implement company-to-companies compatibility matching, since it is well within the skill to ascertain that a company can be matched with one or more participants based on traits, assets, and preferences and one or more participants can be a company.

Pertaining to system Claims 1-4, 19, and 25-27

Rejection of Claims 1-4, 19, and 25-27 is based on same rationale as noted above.

Pertaining to computer readable medium Claims 15-18, 20, and 21

Rejection of Claims 15-18, 20, and 21 is based on same rationale as noted above.

5. **Claims 5-10 are rejected under 35 USC 103(a) as being unpatentable over Durand (patent number 6,272,467), in view of Official Notice (regarding company assets).**

Durand teaches all the above as noted under the 103(a) rejection and teaches a system that provides a) company-to-company compatibility matching for participants desiring to facilitate a relationship, b) matching participant compatibility based on searched traits, assets, and preferences, and c) company size as an asset, but does disclose other company assets. This examiner maintains the position that it is old and well known that companies assess potential business partnerships with other companies by evaluating disclosed assets of target companies (e.g. facilities, technical resources, financials, certifications, and existing partnerships). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Durand to disclose other asset information as taught by Official Notice, in order to facilitate compatibility matching between companies seeking partnerships.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Robert M. Pond
Patent Examiner
July 26, 2004